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OCT 31 2006

Atty Dkt. No.: 10001492-2
USSN: 10/052,928

REMARKS

In view of the following remarks, the Examiner is requested to allow claims 1-35, 67-101 and 144-149, the only claims pending and under examination in this application.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1-34, 67-100 and 144-149 have been rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Balderelli et al. (US 6,015,714) in view of Sampson et al. (US 6,323,043).

In order for Sampson to constitute a proper combination with Balderelli, it must be prior art to the present Application. Since Sampson was published after the filing date of the present Application, sampson can only constitute prior art under 35 U.S.C. § 102 (e).

MPEP § 706.02(I)(1) states:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102 (e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues."

The invention claimed in the instant patent application was subject to an obligation of assignment to Agilent Technologies. An assignment executed by the inventor Jeffrey R. Sampson was recorded on May 21, 2002 (Reel/Frame 012912/0197).

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The Sampson patent application cited as art was owned by Agilent Technologies at the time the claimed invention in that patent application was made, as evidenced by an assignment by the listed inventors to Agilent Technologies, recorded on May 15, 2003 (Reel/Frame 013659/0104).

As can be seen in view of these two assignments, the subject matter of the cited Sampson patent application and the presently claimed invention were, at the time the invention was made, both owned by Agilent or both under an obligation of assignment to Agilent. As such, in accordance with §103(c), the Sampson patent application shall not preclude patentability under §103.

Therefore, the Sampson patent application is not available as prior art against the claimed invention of the present application under §102 (e). The claims thus cannot be rejected under § 103 (a) by a combination that relies upon the disclosure of the Sampson patent application.

Accordingly, the rejection of Claims 1-34, 67-100 and 144-149 under 35 U.S.C. § 103 (a) over Balderelli et al. (US 6,015,714) in view of Sampson et al. (US 6,323,043) may be withdrawn.

Claims 35 and 101 have been rejected under 35 U.S.C. § 103 (a) over Balderelli et al. (US 6,015,714) in view of Sampson et al. (US 6,323,043) and further in view of Thorp. Pursuant to the above analysis, Sampson is not available as prior art to the present application. Accordingly, this rejection may be withdrawn.

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CONCLUSION

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Mike Beck at (408) 553-3864.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10001492-2.

Respectfully submitted,

Date: October 31, 2006

By. 

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